

### **REMARKS/ARGUMENTS**

The Office Action mailed February 17, 2004 has been reviewed and carefully considered. Claims 1-7 were previously canceled. Claims 8 and 10 have been amended. Claims 8-14 are pending in this application, with claim 8 being the only independent claim. Reconsideration of the above-identified application, as herein amended and in view of the following remarks, is respectfully requested.

In the Office Action mailed February 17, 2004, the disclosure is objected to as containing the following minor informalities: (1) on page 5, line 21, reference character "3" is incorrect, (2) Fig. 3 does not show that ring 18 is fastened within sleeve 12 on rod 6, and (3) the text on page 6, lines 19-25 should be deleted. Regarding the first alleged informality, the specification has been amended to change "3" to --2a-- on page 5, line 21. Regarding the second alleged informality, the ring 18 is shown in Fig. 3 as being in the same axial area as axial elongate hole 20. Page 6, lines 23-24 disclose that the axial elongate hole 20 is part of the sleeve section 12. Since the axial elongate hole 20 is part of the sleeve section 12, Fig. 3 does show that the ring 18 is within the sleeve 12. Regarding the last alleged informality, the preliminary amendment instructs to amend the paragraphs starting on page 6, lines 9 and 19, and then lists the two amended paragraphs. Accordingly, this paragraph is replaced with the amended paragraph. In view of the above amendments and remarks, the objections to the disclosure should now be withdrawn.

Claims 8-14 stand rejected under 35 U.S.C. §112, first paragraph, as failing to provide an adequate description of the claim limitations in the specification. The Examiner alleges that it is unclear from the disclosure how the proximal end of the actuation rod 6 is releasably connected to the bar 19. In particular, the Examiner states that the structure of the receiver 22 is unclear. The Examiner further states that it is unclear how the movement of the bar 19 affects the

attachment of rod 6 to bar 19. As delineated in *In re Howarth*, 210 USPQ 689, 691 (CCPA 1981), to meet the enablement requirements under §112 an inventor need not explain every detail since he is speaking to those skilled in the art and what is conventional knowledge will be read into the disclosure. *In re Howarth* at 692 further states that part of the skills of such persons includes not only basic knowledge of the particular art to which the invention pertains, but also the knowledge of where to search for the materials, and public records concerning U.S. Patents are likely to be checked.

U.S. Patent 5,607,449 (Tontarra) discloses that the actuating bar 9 is releasably held by a sleeve 82 which is movable by a pushbutton 82. The sleeve has an opening with a round hole 87 adjoining a narrow slot 88. The sleeve 83 is moved to a release position in which the head 90 of the actuating bar 9 is aligned with and passes through the round hole 87. The sleeve may then be moved so that the narrowed section 93 of the actuating bar 9 is held in the slot for connecting the actuating bar 9. U.S. Patent 5,352,235 (Koros) discloses a similar configuration for releasably connecting a shaft 150 in which a socket has a key shaped opening for selectively engaging an annular groove 165 in the shaft (see Figs. 5-7 and associated text at col. 6, line 53 to col. 7, line 12).

The present application discloses that the proximal end of the actuation rod 6 is releasably connected to the bar 19. The disclosure further states that the bar 19 has a receiver 22 for the positive-fitting insertion of the proximal end of the actuation rod 6 (see page 6, lines 27-28). The specification also states that the bar 19 has a locking position and a release position (page 6, lines 29-32). Therefore, the only specific information not disclosed is the releasable positive-fitting connection. Such a fitting was known to those skilled in the art as disclosed, for example, in U.S. Patent 5,607,449 (Tontarra) and U.S. Patent 5,352,235 (Koros). Accordingly, one skilled in the art would know to provide the proximal end of the with a head and to provide the receiver with a catch

to prevent removal of the actuating rod 6 when the bar 19 is in the locking position and to allow removal of the actuating rod 6 when the bar 19 is in the release position.

To clarify the specification, Fig. 4 is added to show the receiver 22 and proximal end of the actuating rod 6 in accordance with the principles known to those skilled in the art. Since this connection is known to those skilled in the art, as described above, the new Fig. 4 and associated text does not constitute new matter.

Furthermore, the Examiner states that it is not clear how a covering 7 can have a circumferential shape which correspond to the circumferential shape of the trough 5. Claim 10 has been amended to recite that the edge of the trough has a circumferential shape. The specification states on page 5, lines 9-10, that the covering 7 has a strip-like form. By covering section, the specification refers to the part or portion of the covering which covers the trough 5. Since the specification does state that the covering has a strip-like form, there is no way to interpret the shape of the covering in any other manner.

In view of the above amendments and remarks, it is respectfully submitted that the rejection of claims 8-14 under 35 U.S.C. §112, first paragraph, is now overcome.

Claims 8-14 stands rejected under 35 U.S.C. §112, second paragraph as being indefinite because the term "distal" in line 9 of claim 8 should be proximal. Independent claim 8 has been amended to correct this error. Accordingly, the rejection of claims 8-14 under 35 U.S.C. §112, second paragraph, should now be withdrawn.

Claims 8-14 stand rejected under 35 U.S.C. §103 as unpatentable over U.S. Patent No. 4,926,877 (Bookwalter).

Before discussing the cited prior art and the Examiner's rejections of the claims in view of that art, a brief summary of the present invention is appropriate. The present invention

relates to an endoscopic sample taker for collecting a sample of cartilage material. The present invention includes a scoop arranged at a distal end of a shank. The scoop is arranged so that it can be rotated into a hollow space of a patient, such as a knee joint. A handling means 3 with an actuating mechanism 19 is connected to the proximal end of the shank. An actuating rod is releasably connected to the actuating mechanism and a cover is connected to a distal end of the actuating rod, wherein the cover can be moved to cover or open the trough.

Independent claim 8 is amended to clarify that the trough of the scoop is arranged so that the opening at least partially faces the proximal end of the shank. Support for this limitation is found in Figs. 1-3 of the original disclosure.

In contrast to the claimed invention, Bookwalter discloses a biopsy needle having a frustrum at its distal end. The frustrum does not function as a scoop for sampling cartilage. Rather, the biopsy needle must be moved forwardly into the tissue to be sampled. Furthermore, the flexible blade disclosed by Bookwalter does not cover a trough. Rather it closes an end of a cylinder of the biopsy needle. Also, Bookwalter relies on the frusto-conical-shaped distal end of the needle to force the blade into the closed position. There is no motivation for providing a trough having an opening facing a proximal end of the shank on which it is mounted. Furthermore, there is no motivation for providing a cover for such a trough.

Furthermore, Bookwalter fails to teach or suggest that the biopsy needle has a handling means as recited in independent claim 8. Rather, Bookwalter discloses that the thumb actuator 18 is arranged in the hollow shank, i.e., the needle body 12. There is no motivation for providing a handling means with an actuating mechanism, as recited in independent claim 8. In addition, the blade assembly 14 disclosed by Bookwalter is directly connected to the thumb

actuator 18. Accordingly, Bookwalter fails to teach or suggest an actuating rod connected between the actuating mechanism and the cover, as recited in independent claim 8

In view of the amendments and remarks, it is respectfully submitted that independent claim 8 is allowable over Bookwalter.

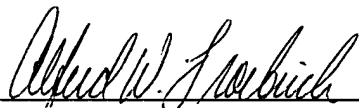
Dependent claims 9-14, being dependent on independent claim 8, are deemed allowable for the same reasons expressed above with respect to independent claim 8.

The application is now deemed to be in condition for allowance and notice to that effect is solicited.

Respectfully submitted,

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Dated: June 17, 2004